

requires a showing that each limitation of a claim must be found in the single reference, practice, or device. *IN RE Donohue*, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). Unlike claim 1 of the instant invention which provides that the peripheral wall be transparent so that anything the student stores on the storage surface is visible through the peripheral wall, this limitation is not taught by the King patent.

Anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference...

There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 18 USPQ2d 1896 (Fed. Cir. 1991). (Emphasis supplied.)

The King patent does not have all of the elements and limitations of the instant student work station: there is no transparent peripheral wall to effectuate safety within the school, therefore the section 102 rejection should be reconsidered and withdrawn. Claims 2-4 and 6-13 are either directly or indirectly dependent on claim 1 and should be allowed on the same basis as claim 1.

Additionally, claims 1-4 and 6-10 do not require the base that is required in the King patent. Claim 11 of the instant invention is the only claim rejected under section 102 having a base element.

The other claims rejected under section 102 do not require the base taught by the King patent.

Reconsideration of Claims 1-4 and 6-13 under 35 U.S.C.102(b) as being unpatentable in view of King is requested in light of the arguments presented herein.

Based on the foregoing, applicant requests that Claims 1-4 and 6-13 be allowed.

35 U.S.C. §103 Rejections

Claim 5 has been rejected under 35 U.S.C. 103(a) as being unpatentable over King '749 in view of Woy (U.S. Patent No. 5,865,516).

Claim 5 is directly dependent on claim 1. As noted above, the patent to King fails to teach the structure of the present invention substantially as claimed as discussed above. The examiner, however, has taken the position that the use of transparent structures to provide a display purpose is a matter of privacy desired and that the patent to Woy teaches the use of providing transparent structural surface to provide a display.

In the case of *R.E. Kaslow*, 707 F.2d 1366 (1983, Fed. Cir.), the court said that a §103 inquiry focuses not on the differences between the claimed subject matter and the prior art, but rather on the subject matter as a whole. It should first be noted that one skilled in the art of desk design would have no reason to look to transparent display cases without having first dissected the

present invention and then finding its elements elsewhere. Relying on the present invention in this way is employing an impermissible hindsight approach.

Approaches to obviousness determinations which focus merely on identifying and tabulating 'missing elements' in hindsight retrospect 'imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, . . . and, . . . fall victim to the insidious effect of hindsight syndrome where that which only the inventor taught is used against its teacher. *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

Student desks have been made for decades without resort to a transparent peripheral wall or a transparent work surface. The prior art goals of desk design included providing a work surface and a private storage area. With respect to storage, the objective has traditionally been privacy, not display. Only with the benefit of the present invention's elements, which achieve the inventor's safety objective, does a transparent peripheral wall and a transparent work surface become apparent. Without this inventor's safety motivated objective, there is nothing in King to suggest that it be joined with Woy. Woy do not teach a solution to a safety objective as is demanded by the instant invention.

Although such criteria are of distinctly secondary importance, satisfaction of a long-felt need is evidence of non-obviousness. *Maclaren v. B-I-W Group, Inc.*, 535 F.2d 1367 (1976 C.A.2 N.Y.). For the first time in decades, a new safety objective has generated a new, otherwise unapparent use of a transparent peripheral wall and work surface to achieve a safety motivated objective. For the above reasons, claim 5 should be allowed.

Reconsideration of Claim 5 under 35 U.S.C.103(a) as being unpatentable over King '749 in view of Woy '516 is requested in light of the arguments presented herein and applicant requests that Claim 5 be allowed.

Claims 14-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over King '749 in view of Woy (U.S. Patent No. 5,865,516) as applied to the claims above, and further in view of Lamm (U.S. Des. 143,494). The examiner has noted that the patent to King in view of Woy teaches structure substantially as claimed including support structure the only difference being that the support does not include three legs. However, the patent to Lamm teaches the use of providing a particular number of supports to be old. Lamm, however, teaches away from the other claimed prior art in that it has a closed circular desk and the use of three legs is completely arbitrary.

Independent claims 14 and 19, each provide new unapparent elements - a transparent peripheral wall and transparent work

surface - to achieve the safety objective not considered or suggested by the referenced prior art. Claims 15-18 and 20 are directly or indirectly dependent on these independent claims and for the reasons set forth above, should be allowed.

Reconsideration of Claims 14-20 under 35 U.S.C.103(a) as being unpatentable over King '749 in view of Woy '516 is respectfully requested in light of the arguments presented herein.

Based on the foregoing, applicant requests that Claims 14-20 be allowed.

CONCLUSION

For all the above reasons, applicant believes that all the claims presented in this application are allowable over the prior art, and any early allowance of the application is earnestly solicited. Formal drawings will be submitted upon notice of allowance.

Respectfully submitted,



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